

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 02-420-H

In re Patent of Rice <i>et al.</i>)	
Patent No.: 7,576,074)	
Application No.: 10/522,004)	Group Art Unit: 1624
Issue Date: August 18, 2009)	
Filing Date: April 11, 2005)	Confirmation No.: 5083
(371(c) Date))	
Entitled: RECEPTOR-TYPE KINASE)	Examiner: MURRAY, Jeffrey H
MODULATORS AND METHODS OF USE)	

**RESPONSE TO THE DECISION ON REQUEST FOR RECONSIDERATION OF
PATENT TERM ADJUSTMENT MAILED DECEMBER 15, 2009**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In light of *Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir. Jan. 7, 2010), patentee requests reconsideration of the Office's Decision on Request for Reconsideration of Patent Term Adjustment, mailed on December 15, 2009, ("the Office decision") for U.S. Patent 7,576,074. Patentee respectfully submits that the Federal Circuit's *Wyeth* interpretation of 35 U.S.C. § 154(b) results in a patent term adjustment (PTA) of 1025 days rather than the 560 days granted in the Office decision and requests appropriate correction.

Under 35 U.S.C. § 154(b), a patent is entitled to additional patent term (*i.e.*, PTA) equal to Patent Office examination delays, § 154(b)(1)(A) ("A delays"), plus application pendency beyond three-years from the application filing date, § 154(b)(1)(B) ("B delays"), minus patent applicant prosecution delays, § 154(b)(2)(C), to the extent that the A and B delay periods do not overlap, § 154(b)(2)(A).

In determining the "overlap" between the A and B delays, the Office stated at page 4 of the Office decision that "the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i) – (iii)), and not just the period beginning three

CERTIFICATE OF TRANSMISSION (37 C.F.R. 1.8)

I hereby certify that this correspondence is being transmitted to the USPTO via the USPTO EFS on January 13, 2010.

Date: January 13, 2010

/Michael S. Greenfield/
Michael S. Greenfield

after the actual filing date of the application is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154 (b)(2)(A).”

However, patentees submit that the Office has misinterpreted “overlap” between the A and B delay periods in construing 35 U.S.C. § 154(b)(2)(A). According to *Wyeth*,

...no “overlap” happens unless the violations occur at the same time. Each “period of delay” has its own discrete time span whose boundaries are defined in section 154(b)(1). That is, each has a start and an end. Before the three-year mark, no “overlap” can transpire between the A delay and the B delay because the B delay has yet to begin or take any effect. If an A delay occurs on one day and a B delay occurs on a different day, those two days do not “overlap” under section 154(b)(2).

No. 2009-1120, slip op. at 8 (Fed. Cir. Jan. 7, 2010). Thus, no “overlap” occurs between the A and B delay periods (i) prior to three-years after the application filing date, or (ii) if the delay does not occur on the same calendar day.

As a result of the Office’s interpretation of “overlap” between the A and B delay periods within 35 U.S.C. § 154(b), the patentee is being denied a portion of patent term to which it is entitled. Specifically, the patentee submits it is entitled to 1025 days of PTA, not the 560 days noted in the Office decision.

Turning to the present case, and as noted in detail in the Office decision, the A delay is 466 days, the B delay is 579 days, patentee’s delay is 19 days, and the A and B periods overlap on one calendar day (October 28, 2008). Following the *Wyeth* decision, patentees submit that the proper PTA is: $466 \text{ (A delay)} + 579 \text{ (B delay)} - 1 \text{ (overlap of A and B periods)} - 19 \text{ (patentee delay)} = 1025 \text{ days}$, not 560 days as calculated by the Office.

The ‘074 patent is not subject to a terminal disclaimer.

Conclusion

For all the reasons stated above, the patentee respectfully submits that the proper PTA is 1025 days and requests appropriate correction.

Fee Authorization: The Commissioner is authorized to charge the cost of any fees that may be associated with the filing of this Petition to Deposit Account No. 13-2490.

If there are any questions or comments regarding this application, the Office is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: January 13, 2010

/Michael S. Greenfield/
Michael S. Greenfield
Registration No. 37,142

Telephone: 312-913-0001
Facsimile: 312-913-0002

McDonnell Boehnen Hulbert & Berghoff LLP
300 South Wacker Drive
Chicago, IL 60606